

REMARKS

Reconsideration and allowance are earnestly, but respectfully requested.

New claims 24, 25, 26, 27, 28 and 29 find basis in the specification at page 4 and the original claims.

Claims 1-2 were rejected as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,697,988 to Malfer in view of U.S. Patent No. 2,536,976 to Cross.

The rejection is traversed.

The Examiner "bears the initial burden, on review of the prior art . . . , of presenting a *prima facie* case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

A rejection cannot be predicated on the mere identification of individual components of claimed limitations. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "[I]t is incumbent upon the examiner to identify some suggestion to combine the references or make the modification." Ex parte Askman, Appeal No. 96-1548 (June 10, 1999) at page 5, quoting In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

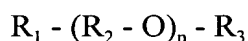
The problem addressed by the present method and the manner of its being addressed are neither disclosed nor would they have been suggested to a person of ordinary skill in the art by the references. "A *prima facie* case of obviousness can be rebutted if the applicant ... can show 'that the art in any material respect taught away' from the claimed invention." In re Geisler, 116 F.3d 1465, 1469 (Fed. Cir. 1997) (quoting In re Malagri, 499 F.2d 1297, 1303 (CCPA 1974)). A reference teaches away when a person of ordinary skill, upon reading the

reference, would have been led in a direction divergent from the path that was taken by Applicants.

The information of record includes PCT WO 00/50543, which is a counterpart of U.S. Patent No. 6,533,830 B1, copy attached. After discussing background prior art, the '830 B1 document discloses "the carrier oils known from the prior art frequently have only limited compatibility with other additives, so that separation may occur. Furthermore, the generally high viscosity of these carrier oils often gives rise to formulation problems. In particular, they are not yet capable of completely eliminating the undersired effect of "sticking of the valves". "Sticking of valves" is understood as meaning complete loss of compression on one or more cylinders of the internal combustion engine if - owing to polymer deposits on the valve shaft - the spinning force is no longer sufficient to close the valves properly.

The '891 B1 document requires $(CH_2)_n$ and does not describe an $(Ar)_n$ moiety. Thus, at the outset, others working in the art did not make the selection to arrive at the invention herein.

The Malfer formula is:



wherein " R_1 is hydrogen or hydroxy, alkyl, cycloalkyl, aryl, aralkyl, alkoxy, cycloalkoxy, amine or amine group having 1-20 carbon atoms; R_2 is an alkylene group having 2-10 carbon atoms; and R_3 is hydrogeh or alkyl, cycloalkyl, aryl, alkyaryl, aralkyl, alkoxy, cycloalkoxy, amine or amino group having 1-200 carbon atoms, and n is an integer from 1 to 500 representing the number of repeating alkyoxy groups," column 5, lines 25-33. R_1 has a plethora of possibilities. For instance, for R_1 there would appear to be at least 200 choices for alkyl, at least 197 choices for cycloalkyl (cyclopropyl etc.). More than 194 choices for aryl (assuming C_6), more than 194 choices for alkaryl, more than 200 choices for alkoxy, at least 197 choices for cycloalkoxy, at least 200 choices for an amine or so it would appear,

and at least 200 choices for amino or so it would appear. R_3 has a similarly vast array of choices. Compare to the pre-selection based on hindsight in the Office Action at page 2.

The Cross reference does not even appear germane to the Malfer reference. The Malfer reference relates to "a novel fuel additive composition" whereas the Cross reference relates to certain sub-genus of compounds of which "many of them are valuable insecticides" (col. 1, lines 16-17); sub-geneous of sulfuric acid terminated compounds that "are valuable surface active agents" (col. 1, lines 21-22); and, for instance, a sub-genus of compounds in which as the number of ethanoxy groups increases, exhibit water-solubility and "are valuable widely used, non-ionic surface active agents," (col. 1, lines 23-25).

It is not seen, except with the aid of proscribed hindsight, what is the basis for selecting the Cross reference, selecting only certain possibilities from amongst the bewildering myriad of choices, and then modifying the Malfer reference with such hindsight-directed selections.

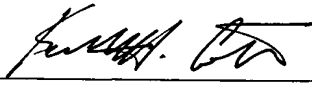
It is furthermore respectfully submitted that the Cross reference does not address the differences between the present inventions and the Malfer reference. For instance, if n is 1 to 20 in the Cross formula (col. 1, lines 1-5), then it is not seen where basis is for rejecting claim 27. For instance, if R in "hydrogen or lower alkyl (i.e., methyl or ethyl)," (Cross at col., lines 8-9), then it is not seen where basis is for rejection claim 28.

Applicants therefore earnestly but respectfully solicit a Notice of Allowance.

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Respectfully submitted,

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